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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,265

12/01/2005

Hayahide Yamasaki

2005-1598A

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7590

08/06/2008

WENDEROTH, LIND & PONACK, L.L.P.

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SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

PEZZUTO, HELEN LEE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,265	Applicant(s) YAMASAKI, HAYAHIDE	
	Examiner Helen L. Pezzuto	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/7/07, 4/1/08, 7/7/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/08 has been entered.

Response to Amendment

Applicant's amendment to claim 1 filed in conjunction with the RCE on 7/7/08 is acknowledged. Currently, claims 1-8 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Fleur et al. (US-399) for the reasons of record.

US 6,593,399 B1 to La Fleur et al. discloses a method of preparing an intrinsically conductive polymer in the presence of emulsion latexes. Specifically, prior art teaches polymerization of at least one cyclic heteroatom-containing monomer (i.e. aniline) in the presence of an emulsion latex copolymer (col. 2, line 28 to col. 3, line 24). Suitable emulsion latex copolymer can be prepared from (meth)acrylic acid, and N-vinylpyrrolidone, encompassing applicant's emulsion polymer expressed in the present claims (col. 3, lines 25-65; col. 10, lines 24-58)). Prior art further teaches using 85 wt% to 100 wt% of monomer or monomer mixtures from groups A and/or B (i.e. (meth)acrylic acid, N-vinylpyrrolidone). Accordingly, it would have been obvious to one having ordinary skill in the art to prepare a polyaniline-containing composition as taught by the method disclosed in US-399, motivated by the reasonable expectation of success. Furthermore, once the motivation to prepare the polyaniline-containing composition is provided, one having ordinary skill in the art would have readily envisaged the relative proportions of vinylpyrrolidone and

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the acid group-containing monomers used in the emulsion latex as well as the content of polyaniline under the general guidance of prior art disclosure via routine experimentation. Regarding the recited emeraldine-type of polyaniline, the examiner is of the position that it is inherent in prior art product because applicant's product and that of the prior art appear to be substantially identical, as a dark green appearance was exemplified in the working examples using aniline as the cyclic heteroatom-containing monomer (see Examples 15, 19, 21, 23, 25, 27, 29, 31, 34, 36, and 38), indicative of the emeraldine-type product. Finally, the examiner takes notice that the recited polyaniline-containing composition is now recited in the product-by-process format. It is well established that the patentability of the claimed invention is determined based on the product itself, not on the method of making it. When applicant's product and that of the prior art appear to be substantially identical or obvious, the burden shifts to applicant to provide evidence that the respective products do in fact differ and prior art product does not necessarily or inherently possess the relied upon characteristics of applicant's claimed product.

Response to Arguments

Applicant's amendment and remarks filed on 7/7/08 have been fully considered but are not found to be persuasive. The crux of applicant's arguments lies in the claimed composition has higher conductivity, sufficient water resistance, strength and flexibility as compared to the product of La Fleur et al. Applicant further points to Comparative Example 2 in support the alleged showing of unexpected results. The examiner respectfully disagrees. Firstly, the Comparative showing of record is not clear and convincing as they are not performed in a side-by-side manner. The emulsion composition (1) produced by Reference Example 1, which is used in Comparative Example 2, does not contain N-vinylpyrrolidone as compared to that in Example 1. Secondly, it has been held that to overcome a reasonable case of prima facie obviousness, a given claim must be commensurate in scope with any showing of unexpected results. The features or properties upon which applicant relies are not recited in the rejected claims. Accordingly, the examiner's position is maintained.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/
Primary Examiner
Art Unit 1796

hlp

Application Number 	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/553,265	YAMASAKI, HAYAHIDE	
	Examiner	Art Unit	
	Helen L. Pezzuto	1796	